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10/518,668	08/22/2005	Ulrike Wachendorff-Neumann	2400.0260001	6799

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EXAMINER

QAZI, SABIHA NAIM

ART UNIT	PAPER NUMBER
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1612

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/518,668	Applicant(s) WACHENDORFF-NEUMANN ET AL.	
	Examiner Sabiha Qazi	Art Unit 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Non-Final Office Action

Claims 9-15 are pending. No claim is allowed at this time.

Summary of this Office Action dated January 19, 2008

1. Continued Examination Under 37 CFR 1.114
2. Information Disclosure Statement
3. Copending Applications
4. Specification
5. 35 USC § 103(a) Rejection
6. Response to Remarks
7. Communication

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/29/07 has been entered.

Claim Rejections - 35 USC § 103

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Copending Applications

Applicants must bring to the attention of the examiner, or other Office official involved with the examination of a particular application, information within their knowledge as to other copending United States applications, which are "material to patentability" of the application in

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question. MPEP 2001.06(b). See Dayco Products Inc. v. Total Containment Inc., 66 USPQ2d 1801 (CA FC 2003).

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Rejection Under 35 U.S.C. 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over, ISENRING et al. (United States Patent No. 6407, 100), HEINEMANN et al. (US Patent 6,103,717), STENZEL KLAUS et al. (CA 2367361, IDS reference) and JAUTELAT et al. (US Patent 5,789,430). All these references teach the compounds as antimicrobial agents, which embraces Applicant's claimed invention.

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ISENRING teaches trifloxystrobin as fungicide. See the entire document especially lines 10-20 in column 1, lines 34-67 in column 6, abstract, and examples.

HEINEMANN teaches fuoxastrobin as antimicrobial agent. See the entire document especially examples 1-3 in column 15 and 16. These compounds have powerful microbial activity and are useful for controlling undesired microorganism. See lines 39-67 in column 10, lines 1-60 in column 11.

KLAUS teaches (-)enantiomer of 2-[2-(1-chloro-cyclopropyl)-3-(2-chlorophenyl)-2-hydroxypropyl]-2,4-dihydro-[1,2,4]-triazole-3-thione, (prothioconazole) which has better activity than the racemic mixture. See the entire document especially abstract; Table A on page 21 and Table B on page 23. Laevorotatory enantiomer has been disclosed to possess better activity.

JAUTELAT teaches prothioconazole as microbicides. See the entire document especially example 1 in column 35, lines 27-64 in column 29, lines 1-55 in column 30.

Instant claims differ from the reference in claiming the synergistic combination of all three known compounds useful as antimicrobial and antifungal agents.

It would have been obvious to one skilled in the art at the time the invention was made to combine known compounds for the same purpose in expectation to get a better activity. Since all

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the above cited reference teach the active compounds It is *prima facie* obvious to combine two or more compositions each of which is taught by the prior art to be useful for the same purpose in order to form a new composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. *In re Kerkhoven*, 205 USPQ 1069. No synergism has been noted.

Furthermore, because of each compound appears to be well known in the prior art, it would appear that the combination of the compounds would have been obvious in view of MPEP 2144.06 and see *Ex parte Quadranti*, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992).

See *Ex parte Quadranti* where it was held that “There is no single, appropriate test for determining whether synergism has been demonstrated for chemical combination; rather, facts shown in each case must be analyzed to determine whether chosen method has clearly and convincingly demonstrated existence of synergism or unobvious result”. “Assuming arguendo that the differences in values presented are statistically significant, there is no evidence that they represent a true, practical advantage. *In re Freeman*, 474 F.2d 1318, 177 USPQ 139 (CCPA 1973); *In re Klosak* , 455 F.2d 1077, 173 USPQ 14 (CCPA 1972); *In re D'Ancicco*, 439 F.2d 1244, 169 USPQ 303 (CCPA 1971). Also, prescinding from the Colby formula test, which as we have already indicated is at best controversial and in our view probably invalid, there is no evidence that the differences are unexpected. *In re Merck*, 800 F.2d 1091, 231 USPQ 375 (Fed.Cir. 1986); *In re Longi* , 759 F.2d 887, 225 USPQ 645 (Fed.Cir. 1985); *In re Freeman*, *supra*” .

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In absence of any criticality and/or unexpected results presently claimed subject matter, which is the combination of known compounds, would have been obvious at the time of invention to one skilled in the art.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

Data in Specification

Data presented in specification presented on page 11 has been considered. Applicant's argument about calculations was found persuasive. However, the efficacy of fluoxastrobin (III) was found to be 67% and for the mixture of all three compound (1:2:1) is 78% which appear to be not much different to be synergistic.

Declaration and Response to Remarks

Declaration filed Dr. Peter Dahmen on 10/29/2007 has been considered by the examiner. Example 1 presents calculated 53 and found 88 (1:1:2) and in example 3 calculated is 29 and observed is 86 (1:1:2) which appears to be synergistic. However, data presented for example 2 (1:2:1) is not synergistic because calculated is 98 and observed is 100. The data clearly shows that all the ratios of the combination of the compounds of formula (I), (II) and (III) cannot be predicted as synergistic. Applicant may get the ratios showing synergism. Claims are not limited to such ratios. The combination of the three compounds for the same purpose would have been obvious to one skilled in the art at the time invention was filed. Furthermore, because


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of each compound appears to be well known in the prior art, it would appear that the combination of the compounds would have been obvious in view of MPEP 2144.06 and also see Ex parte Quadranti, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992).

Examiner notes, that the name of the compound of formula (I) is missing in claim 9. Applicant is requested to insert the name of the compound.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi, Ph.D. whose telephone number is 571-272-0622. The examiner can normally be reached on any business day. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D. can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SABIHA QAZI, PH.D.
PRIMARY EXAMINER